

REMARKS

In the Office Action dated July 2, 2003, the Examiner rejected claims 1, 2, 4, 9, 10, 13, 14, and 29 under 35 U.S.C. § 102(e) as being anticipated by Ho et al. (U.S. Patent No. 6,408,181); rejected claims 15-17, 28, and 30 under 35 U.S.C. § 102(e) as being anticipated by Wang et al. (U.S. Patent No. 6,526,033); rejected claims 3, 5-8, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of Wang; and rejected claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Farris et al. (U.S. Patent No. 6,574,216).

The Examiner also allowed claims 25-27, and objected to claims 18 and 22-24 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the recitations of each claim's base claim and any intervening claims. Applicant thanks the Examiner for the indication of allowable subject matter.

By this Amendment, Applicant has amended claims 18 and 22 as suggested by the Examiner to include all of the recitations of each claim's base claim and any intervening claims. Claims 18 and 22 are therefore allowable. In addition, claims 23 and 24 depend from rewritten claim 22 and are therefore allowable due to their dependence from allowable claim 22. Applicant respectfully requests the Examiner to withdraw the objection and allow claims 18 and 22-24 in the next Office Action.

Applicant traverses the rejection of claims 1, 2, 4, 9, 10, 13, 14, and 29 under 35 U.S.C. § 102(e) as being anticipated by Ho.

To properly anticipate Applicant's claimed invention, the Examiner must find each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must

be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites a combination including, among other things, “identifying a mobile identification number associated with the mobile terminal,” “determining a route that excludes a home node associated with the identified mobile identification number when a visited node serves the identified mobile identification number,” and “sending the received data to the mobile terminal on a connection initiated by the server and established via the determined route.” Ho does not disclose at least these features of Applicant’s claimed invention.

By contrast, Ho discloses a method and system for improving overall system capacity in GSM networks by reducing the number of home location register and visitor location queries. See Abstract. Further, as disclosed by Ho, when the next call for a mobile terminal with a MSISDN (Mobile Subscriber ISDN) number arrives, the GMSC (Gateway Mobile Switching Center) first checks if a MSRN (Mobile Subscriber Rooming Number) for that called mobile terminal already exists in the cache register. If a cached MSRN is available, then the GMSC will use the cached MSRN to route the call to the VMSC. See col. 6, lines 18-27.

Ho, however, does not disclose or suggest at least “determining a route that excludes a home node associated with the identified mobile identification number when a visited node serves the identified mobile identification number” (emphasis added).

Accordingly, Ho does not anticipate Applicant's claim 1 for at least this reason.

Applicant respectfully requests that the Examiner withdraw the rejection of claim 1.

Moreover, the Examiner alleges in the Office Action (page 2) that a "server is considered here to be an inherent component of a data processing system that handles databases." To properly anticipate claim 1 under 35 U.S.C. § 102(e), Ho, taken individually, must explicitly disclose each and every element recited in the claim. See M.P.E.P. § 2131 (7th ed. 1998). If Ho, however, fails to expressly set forth a particular element, then the Examiner must show that this limitation is inherently disclosed to substantiate a claim of anticipation. See In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999). To establish inherency, the Examiner must specifically identify extrinsic evidence that makes clear to one skilled in the art that the missing element "is necessarily present" in the Ho disclosure. See *id.*; see also Continental Can Co. v. Monsanto. Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991). Accordingly, Applicant submits that Ho does not anticipate claim 1 because the Examiner has not specified extrinsic evidence that makes it clear that the missing element is necessarily present in Ho.

Claim 29 includes features of a similar scope as allowable claim 1. Applicant respectfully requests that the Examiner allow claim 29 for at least the same reasons as discussed above in connection with allowable claim 1.

In addition, claims 2, 4, 9, 10, 13, and 14 depend from allowable claim 1 and are allowable for at least the same reasons as discussed above. Applicant respectfully requests that the Examiner withdraw the rejection and allow these dependent claims.

Applicant traverses the rejection of claims 15-17, 28, and 30 under 35 U.S.C. § 102(e) as being anticipated by Wang.

Claim 15 recites a combination including, among other things, “sending the data packets to a server for communicating the data packets to the mobile terminal on a connection initiated by the server such that the connection is established via a route that excludes a home node associated with the mobile terminal when the mobile terminal resides outside of a geographical area served by the home node.” Wang does not disclose at least these features of Applicant’s claimed invention.

By contrast, Wang discloses a method and system for integrating wireless/wireline and circuit/packet networks for cellular/PCS servers so that GSM subscribers roaming into CDMA networks can be provided with basic call delivery cellular services as long as the roamers can pay their bills with valid credit cards. See Abstract. Further, Wang teaches that calls are delivered to GSM subscribers that roam from their home GSM networks to CDMA networks by using IP tunnels to convey the calls to be delivered. See col. 8, lines 49-53.

However, Wang does not disclose or suggest at least “sending the data packets to a server for communicating the data packets to the mobile terminal on a connection initiated by the server such that the connection is established via a route that excludes a home node associated with the mobile terminal when the mobile terminal resides outside of a geographical area served by the home node” (emphasis added). There is no teaching or suggestion in Ho of establishing a route that excludes any node let alone the home node. In fact, Ho includes the home node as explained above. Accordingly, Wang does not anticipate Applicant’s claim 15 for at least this reason. Applicant respectfully requests the Examiner to withdraw the rejection of claim 15.

Dependent claims 16-17 depend from allowable claim 15 and are allowable at least for the reasons discussed above. Applicant respectfully requests that the Examiner withdraw the rejection of these dependent claims.

Claims 28 and 30 recite combinations including recitations of a similar scope as claim 15. Applicant respectfully requests that the Examiner allow claims 28 and 30 for at least the same reasons as discussed above in connection with allowable claim 15.

Applicant traverses the rejection of claims 3, 5-8, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of Wang.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Each of claims 3, 5-8, 11, and 12 depend from allowable claim 1 and require at least "determining a route that excludes a home node associated with the identified mobile identification number when a visited node serves the identified mobile identification number." As discussed above, Ho does not disclose or suggest at least this feature of claim 1. Moreover, as discussed above, Wang does not disclose or

suggest at least these features and thus does not make up for the deficiencies of Ho. Accordingly, neither Ho nor Wang, either taken alone or in combination, disclose or suggest the features of claims 3, 5-8, 11, and 12, which depend from allowable claim 1.

In addition, Applicant takes issue with the Examiner's presumed Official Notice found in rejecting claims 3, 8, 11, and 12 (Office Action, pages 8-10). Applicant refers the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice." In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding" (Memorandum, p. 3). Applicant submits that the Examiner has made a generalized statement regarding Applicants' claims 3, 8, 11, and 12 without any documentary evidence to support it. Applicant traverses the Examiner's taking of "Official Notice," noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *Id.* at 1. Applicant submits that "[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the arguments presented herein, Applicant submits that the Examiner must provide "the explicit basis

on which the examiner regards the matter as subject to official notice and allow Applicant to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made” (*Id.* at 3, emphasis in original), or else withdraw the rejection.

Applicant traverses the rejection of claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Farris.

Claim 19 recites a combination including, among other things, “a first table including information for identifying a mobile identification number associated with the mobile terminal” and “code for receiving from the wireline terminal one or more data packets destined for the mobile terminal, and for determining a route that excludes a home node associated with the mobile identification number when a visited node serves the mobile identification number, and for establishing via the determined route a connection to the mobile terminal, and for sending the data packets on the established connection to the mobile terminal.” Wang nor Farris, taken alone or in combination, disclose or suggest at least these features.

By contrast, as discussed above, Wang discloses a method and system for improving overall system capacity in GSM networks by reducing the number of home location register and visitor location queries. In addition, the Examiner admits Wang is “silent on the code and process for running the code.” (Office Action, page 10).

Farris, however, does not make up for the deficiencies of Wang. Instead, Farris discloses monitoring the quality of service existing in a data packet network while a voice call is communicated through a data network. See Abstract. In particular, Farris discloses receiving a packet data message from a node of a network, and analyzing

point code information in the packet and routing the packet according to a stored translation table. See col. 7, lines 1-6. However, Farris does not disclose or suggest at least “code for receiving from the wireline terminal one or more data packets destined for the mobile terminal, and for determining a route that excludes a home node associated with the mobile identification number when a visited node serves the mobile identification number, and for establishing via the determined route a connection to the mobile terminal, and for sending the data packets on the established connection to the mobile terminal” (emphasis added).

In addition, the Examiner alleges Wang and Farris are combinable because “they share a common endeavor (Office Action, page 11). Wang discloses integrating wireless/wireline and circuit/packet networks for cellular/PCS servers so that GSM subscribers roaming into CDMA networks can be provided with basic call delivery cellular services as long as the roamers can pay their bills with valid credit cards. Farris discloses monitoring the quality of service existing in a data packet network while a voice call is communicated through a data network. Applicant submits that the Examiner’s allegation that the references share a “common endeavor” does not constitute a suggestion or motivation to combine the references in a manner that would result in Applicant’s claimed invention. Furthermore, the Examiner has not established a reasonable expectation of success for the proposed combination. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 19 for at least the above reasons.

Claims 20-21 depend from allowable claim 19. Accordingly, these claims are allowable for at least the same reasons as discussed above on connection with claim

19. Applicant respectfully requests the Examiner to withdraw the rejection and allow these claims.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2339.

Respectfully submitted,

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